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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,136	10/31/2003	Tadashi Shiraishi	F-8019	3465
28107	7590	05/02/2006	EXAMINER	
JORDAN AND HAMBURG LLP			CARRILLO, BIBI SHARIDAN	
122 EAST 42ND STREET			ART UNIT	
SUITE 4000			PAPER NUMBER	
NEW YORK, NY 10168			1746	

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**  
**Before the Filing of an Appeal Brief**

Application No.

10/699,136

Applicant(s)

SHIRAIISHI, TADASHI

Examiner

Sharidan Carrillo

Art Unit

1746

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 19 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1 and 6.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: for the reasons set forth herein.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
**SHARIDAN CARRILLO**  
**PRIMARY EXAMINER**

Sharidan Carrillo  
Primary Examiner  
Art Unit: 1746

Continuation of 3, NOTE: The additional limitations as set forth in claims 13-17 would require further search and consideration.

## **DETAILED ACTION**

### ***Advisory Action***

1. The rejection of claim 6, under 112, first paragraph, new matter, is withdrawn in view of arguments and support in the instant specification.
2. The After-Final Amendment of 4/13/2006 will not be entered because it raises new issues which would require further search and consideration.
3. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).
4. Applicant argues that one skilled in the art would not have a reasonable expectation of success since Barry teaches using propelled pigs instead of suction as a driving means. Applicant argues that Barry cannot be modified to include the use of suction since it would be counterproductive and diametrically opposed to the pressure propelled method. The use of suction as a driving means would not be counterproductive since it serves as an alternative means for achieving the same purpose of cleaning the interior of the pipe. Additionally, the skilled artisan would

recognized the advantages of using a suction means as compared to a launcher since the former would require less equipment and easier to use.

5. Applicant argues that there is no suggestion as to how the ice pigs could be automatically transferred from a hopper without outside intervention or assistance.

Applicant's arguments are unpersuasive because they are not commensurate in scope with the instantly claimed invention. Additionally, Barry teaches using a hopper in which pigs may be fed into the launcher. The modification of Barry to include a suction means would result in the pigs being fed from the hopper into the tubing and further suctioned to remove contaminants therefrom. It is well known in the art, as evidenced by Fujii (JP58-3686) to deliver ice cubes directly from a container into the piping and abrasively cleaning the piping by applying a suction means.

6. Applicant further argues that there is no reasonable expectation of success since there is no indication that the same fouling agents present in the sewer and water lines will have the same characteristic as the heat exchangers. Applicant's arguments are unpersuasive because they are not commensurate in scope. Additionally, since both references teach cleaning the interior of the piping, one would reasonably expect the abrasive cleaning with ice cubes to remove contaminants present on the interior of the tube.

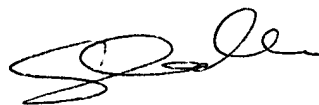
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheridan Carrillo whose telephone number is 571-272-1297. The examiner can normally be reached on M-W 6:30-4:00pm, alternating Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on 571-272-1414. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sheridan Carrillo  
Primary Examiner  
Art Unit 1746

bsc

A handwritten signature in black ink, appearing to read 'S. Carrillo', with a stylized flourish at the end.

SHARIDAN CARRILLO  
PRIMARY EXAMINER